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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/805,361

03/22/2004

Yoshitada Himeno

04329.3285

9473

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7590

03/04/2008

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EXAMINER

STRONCZER, RYAN S

ART UNIT

PAPER NUMBER

4157

MAIL DATE

DELIVERY MODE

03/04/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/805,361

**Applicant(s)**

HIMENO ET AL.

**Examiner**

Ryan Stronczer

**Art Unit**

4157

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 March 2004 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date 03/22/2004, 10/31/2006
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

***Claim Objections***

Claim 2 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 2 recites the apparatus of claim 1 but is directed to elements of the system recited in the preamble of claim 1 and not to the apparatus to which claim 1 is directed.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claims 1-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

**Claims 1 and 2 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 1 recites the broad recitation "*a system including a plurality of terminals...and a plurality of access providers disposed between the electronic merchandise distribution apparatus and...the plurality of terminals...*", and the claim also recites "*an electronic merchandise distribution apparatus*," which is the narrower statement of the range/limitation. It is unclear whether the system recited in the preamble is necessary for the implementation of the recited apparatus or if it is merely an example of intended use for said apparatus. Likewise, claim 2 recites the apparatus of claim 1 but is directed to elements of the system recited in the preamble of claim 1 and not to the apparatus to which claim 1 is directed.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1 and 10 are rejected under 35 U.S.C. 102(e) as being anticipated by Deshpande et al. (Pub. No.: US 2004/0006768).**

Applicant is advised that the system recited in the preamble of claim 1 states purpose or intended use rather than any distinct definition of any of the claimed invention's limitations, and thus is not considered a limitation of the apparatus to which the claim is directed. See MPEP § 2111.02. Claim 1 recites *"an electronic merchandise distribution apparatus applied to a system including a plurality of terminals capable of receiving an electronic program guide (EPG) and contents..."* Fig.1 of Deshpande teaches a content distribution system **106** which distributes an EPG to a plurality of user terminals. As to the *"... plurality of access providers disposed between the electronic distribution apparatus and at least part of the plurality of terminals..."* recited in the preamble, Fig. 1 of Deshpande also teaches that content and said EPG(s) are delivered to the content distribution system from one or more content providers and program data providers. As to the recited *"information management unit,"*, the distribution system of

Deshpande is responsible for receiving user requests for content and distributing said content to the user. In responding to a user request, it is inherent that the distribution system would need to acquire *“user retrieval information,”* as recited. As to the recited, *“distribution management unit which stores non-real-time contents compressed by a CODEC, in an access provider corresponding to one of the plurality of terminals used by the user, based on the acquired at least one of the viewing information, preference information, and retrieval information of the user, prior to receiving the contents viewing request from the user. distribution management unit which stores non-real-time contents compressed by a CODEC, in an access provider corresponding to one of the plurality of terminals used by the user, based on the acquired at least one of the viewing information, preference information, and retrieval information of the user, prior to receiving the contents viewing request from the user.”* Deshpande teaches that the content processing application 132 taught in Fig. 1 receives content from a content provider prior to transmitting the content across the broadcast network [0021]. Furthermore, *“A particular content processing application may encode or otherwise process the received content into a format that is understood by the multiple client devices.”* The content distribution system taught by Deshpande provides identical functionality as that recited in claim 1.

Applicant is advised that the system recited in the preamble of claim 10 states purpose or intended use rather than any distinct definition of any of the claimed invention's limitations, and thus is not considered a limitation of the method to which the claim is directed See MPEP § 2111.02. The rejection of claim 1 is incorporated herein.

Deshpande teaches a content distribution system which performs the functionality of the recited distribution apparatus. Since the distribution system taught by Deshpande performs the same functionality as the recited distribution apparatus, it is inherent that implementing the system taught by Deshpande would have provided the same functionality as the method recited in claim 10.

**Claims 18 and 19 are rejected under 35 U.S.C. 102(e) as being anticipated by Ellis et al. (Pub. No.: US 2003/0149988, hereinafter Ellis '478).**

Claim 18 recites an electronic merchandise distribution method which facilitates the purchase of content over a distribution network and which allocates the system operator's commission, the distribution apparatus' commission, and the royalties owed to the content creator for said content. Ellis '478 teaches an interactive content distribution system which distributes media content to users and also comprises a "billing system which receives information from interactive program guide television equipment 17 regarding programs that are ordered, recorded, or played back on interactive program guide television equipment 17. Billing system 199 may be any computer based system suitable for generating bills for users or crediting and debiting accounts of users based on the information received from interactive program guide television equipment 17" [0061]. Transactions such as allocating the commissions for the system operator and distribution apparatus as well as the royalties owed to the content creator as claimed are an inherent part of conducting business in a content

distribution environment and would necessarily have been performed by the billing system taught by Ellis '478.

Claim 19 is rejected by Ellis '478 as applied to claim 18.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 2 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Deshpande et al. (Pub. No.: US 2004/0006768).**

Claim 2 recites the apparatus of claim 1 wherein each of the access providers includes *“first distribution server capable of storing the contents sent from the electronic merchandise distribution apparatus and distributing the stored contents, and a plurality of second distribution servers capable of storing the contents sent from the first distribution server and distributing the stored contents to one of the plurality of terminals used by the user when receiving the contents viewing request from the user.”* Examiner notes that the recited distribution server and access provider is cumulative with a cable headend and takes Official Notice that it is well known in the art for a distribution system to employ one or more head ends to distribute content to a user and that implementing the system taught by Deshpande would have rendered obvious the claimed subject matter.



Claim 11 recites the method of claim 10 further comprising *"storing the contents sent from the...distribution apparatus in a first distribution server in each of the plurality of access providers and distributing the stored contents; [and] storing the contents sent from the first distribution server in a plurality of second distribution servers in each of the plurality of access providers and distributing the stored contents to one of the plurality of terminals used by the user when receiving the contents viewing request from the user."*

Examiner notes that the recited distribution server and access provider is cumulative with a cable headend and takes Official Notice that it is well known in the art for a distribution system to employ one or more head ends to distribute content to a user and that implementing the system taught by Deshpande would have rendered obvious the claimed subject matter.

**Claims 3-8 and 12-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Deshpande et al. as applied to claims 1 and 10 above, and further in view of Ellis et al. (US Pat. No.: 6,898,762, hereinafter Ellis '762).**

Claim 3 recites the apparatus of claim 1, wherein *"the information management unit includes a viewing information collection and management unit which collects and manages viewing information of contents viewed by viewers at each terminal; and the distribution management unit distributes EPG or contents on which the viewing information is reflected."* Due to the poor grammatical construction of the claim language, it is not explicitly clear what is reflected by the distributed content or EPG. For the purposes of applying prior art, the claim is interpreted to mean that the

distribution management unit distributes content or EPG data which corresponds with the viewer preference information collected by the information management unit. While Deshpande teaches a content distribution system which performs the function of the apparatus of claim 1, it does not explicitly teach collecting information based on user viewing history of preference. Fig. 13a-f of Ellis '762 teaches an interface which allows users to set preferences of various programs available to them. Furthermore, Fig. 15 shows an example of a list of programs available to a user after defining their preference profile. Additionally, Ellis teaches that "User data, such as user preference profiles, preferences, parental control settings, record and reminder settings, viewing histories, and other suitable data may also be stored on storage device 56 by program guide server 25...The program guide may process user profiles along with the viewer histories to present a more customized viewing experience to the user. The program guide may, for example, identify which programs or series episodes users have watched." (Col. 6, Lines 13-17; Col. 19, Lines 47-51). It would have been obvious to one of ordinary skill at the time of the invention to combine the content distribution system of Deshpande with the preference and user history functionality taught by Ellis '762 to provide users with the benefit of having shows they prefer readily available to them.

Claim 4 is rejected by Deshpande et al. and Fig. 13a-f and Fig. 15 of Ellis '762 as applied to claim 3.

Claim 5 is rejected by Deshpande et al. and Ellis '762 as applied to claim 4.

Claim 6 is rejected by Deshpande et al. as applied to claim 1.

Claims 7 is rejected by Deshpande et al. and Ellis '762 as applied to claim 3.

Claims 8 is rejected by Deshpande et al. and Ellis '762 as applied to claim 4.

Claim 12 recites the method of claim 10 further comprising, *"providing, by the electronic merchandise distribution apparatus, a contents retrieval result on which the viewing information depending on a contents retrieval request from a terminal is reflected."* The rejection of claim 3 is incorporated herein. Ellis '762 teaches a method by which the program guide may utilize user viewing history to "present a more customized viewing experience" (Col. 19). As applied to claim 3, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Deshpande and Ellis '762 to allow users to customize the content selections presented to them.

Claim 13 recites the method of claim 10 further comprising *"acquiring and managing, by the electronic merchandise distribution apparatus, preference information of contents favored by viewers at each terminal to distribute EPG or contents on which the preference information is reflected."* As applied to claim 3, Fig. 13a-f and Fig. 15 of Ellis '762 teach an interface which allows users to set preferences of various programs available to them and an example of a list of programs available to a user after defining their preference profile, respectively. As applied to claim 12, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Deshpande and Ellis '762 to allow users to customize the content selections presented to them.

Claim 14 is rejected by Deshpande et al. and Fig. 13a-f and Fig. 15 of Ellis '762 as applied to claim 13.

Claim 15 is rejected by Deshpande et al. as applied to claims 1 and 10.

Claim 16 is rejected by Deshpande and Ellis et al. as applied to Claims 12. It would have been obvious to one of ordinary skill in the art that the user-specific viewing information would have to be collected initially by the user's client device.

Claim 17 is rejected by Deshpande and Ellis et al. as applied to claim 16.

**Claim 9 is rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Deshpande et al.**

The recited *"electronic merchandise receiving terminal capable of receiving [EPG] and contents distributed from an electronic merchandise distribution apparatus"* is taught by Deshpande as a client device as such: "A client device **108** can be implemented as a set-top box, a satellite receiver, a TV recorder with a hard disk, a digital video recorder (DVR) and playback system, a personal video recorder (PVR) and playback system, a game console, an information appliance, and as any number of similar embodiments" [0023]. As to the recited first and second processing units, while Deshpande does not explicitly teach a specific number of processing units, the client devices taught by Deshpande are inherently capable of performing the recited tasks of requesting content from an access provider and receiving and displaying the requested content to the viewer, as well as saving the content received from the access provider. While Deshpande does not teach a specific number of processing units for

accomplishing the recited tasks, it would have been obvious to one of ordinary skill in the art at the time of the invention that separate processing units might be utilized for requesting content from the service provider and for receiving and displaying said content to the user.

### **Contact**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ryan Stronczer whose telephone number is (571) 270-3756. The examiner can normally be reached on 7:30 AM - 5:00 PM, Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vu Le can be reached on (571) 272-7332. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Examiner, Art Unit 4157

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